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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,707	10/27/2005	Masataka Kuwana	4439-4036	2198

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MORGAN & FINNEGAN, L.L.P.  
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NEW YORK, NY 10281-2101

EXAMINER

DUTT, ADITI

ART UNIT	PAPER NUMBER
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1649

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/549,707	<b>Applicant(s)</b> KUWANA ET AL.	
	<b>Examiner</b> Aditi Dutt	<b>Art Unit</b> 1649	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, 17-18, drawn to a monocyte-derived multipotent cell and a therapeutic agent comprising the multipotent cell.

Group II, claim(s) 9-10 drawn to a method for preparing a monocyte-derived multipotent cell.

Group III, claim(s) 11-12 drawn to a mesenchymal progenitor, mesenchymal cell or a mesenchymal tissue.

Group IV, claim(s) 13 drawn to a myocardial progenitor, myocardial cell or a myocardial tissue.

Group V, claim(s) 14 and 18, drawn to a neural progenitor, neuron or a nerve tissue and a therapeutic agent.

Group VI, claim(s) 15 drawn to an endothelial progenitor, endothelial cell or a endothelial tissue.

Group VII, claim(s) 16-17, drawn to a mesodermal progenitor, mesodermal cell or a mesodermal tissue and a therapeutic agent comprising the cells.

Group VIII, claim(s) 19-20 drawn to a treating method comprising administering the monocyte-derived multipotent cell.

Group IX, claim(s) 19, drawn to a treating method comprising administering the mesodermal progenitors, cells or tissues.

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Group X, claim(s) 20 drawn to a treating method comprising administering the neural progenitors, cells or tissues.

2. The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

This PCT rule defines special technical features as technical features that identify a contribution which each of the claimed inventions, considered as a whole, makes over prior art. Claims 1-8 and 17-18 are anticipated by prior art. Kuwana et al (Jour Leukocyte Biol 74: 833-845, 2003) teaches monocyte-derived mesenchymal progenitor cells, that were generated in vitro from peripheral blood mononuclear cells, and which have phenotype CD14, CD45 and CD34 (abstract, page 835-Results: page 838, Figure 2). Therefore, claims 1-8 and 17-18 lack a special technical feature and cannot share one with the other claims.

Group I recites the special technical feature of a monocyte derived multipotent cell, which is not required by the other products of Groups III-VII.

Group II recites the special technical feature of preparing a monocyte-derived multipotent cell, which is not required by the other methods of Groups II and VIII-X.

Group III recites the special technical feature of a mesenchymal progenitor, mesenchymal cell or a mesenchymal tissue, which is not required by the other products of Groups I, and III-VII.

Group IV recites the special technical feature of a myocardial progenitor, myocardial cell or a myocardial tissue, which is not required by the other products of Groups I, III and V-VII.

Group V recites the special technical feature of a neural progenitor, neuron or a nerve tissue and a therapeutic agent, which is not required by the other products of Groups I, III-IV, VI-VII.

Group VI recites the special technical feature of an endothelial progenitor, endothelial cell or a endothelial tissue, which is not required by the other products of Groups I, III-V, and VII.

Group VII recites the special technical feature of a mesodermal progenitor, mesodermal cell or a mesodermal tissue and a therapeutic agent comprising the cells, which is not required by the other products of Groups I and III-VI.

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Group VIII recites the special technical feature of treating method comprising administering the monocyte-derived multipotent cell, which is not required by the other methods of Groups II and IX-X.

Group IX recites the special technical feature of a treating method comprising administering the mesodermal progenitors, cells or tissues, which is not required by the other methods of Groups II, VIII and X.

Group X recites the special technical feature of a treating method comprising administering the neural progenitors, cells or tissues, which is not required by the other methods of Groups II, and VIII-IX.

3. In response to this Office Action/Election requirement, applicant must elect one from Groups I-X for consideration.
4. Applicant is advised that in order for the reply to this requirement to complete it must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48 (b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. 1.48(b) and by the required under 37 C.F.R. 1.17(I).

### ***Notice of Rejoinder***

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is

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subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

Amendments submitted after final rejection are governed by 37 CFR 1.116;

amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply

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where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

***Advisory Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aditi Dutt whose telephone number is 571-272-9037.

The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AD  
08 December 2006

  
**BRENDA BRUMBACK**  
**SUPERVISORY PATENT EXAMINER**  
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